

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number:  00633-041001
<p>I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.</p> <p>_____</p> <p>Date of Deposit</p> <p>_____</p> <p>Signature</p> <p>_____</p> <p>Typed or Printed Name of Person Signing Certificate</p>	Application Number  10/712,294	Filed  November 13, 2003
	First Named Inventor  Dimitri T. Azar	
	Art Unit  3738	Examiner  William H. Matthews
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>56,569</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: right;"> <p>_____ /Elliott J. Mason, III Reg. No. 56,569/ Elliott J. Mason, III</p> <p>_____ Elliott J. Mason, III Typed or printed name</p> <p>_____ (617) 542-5070 Telephone number</p> <p>_____ October 19, 2007 Date</p> </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.</p>		
<input checked="" type="checkbox"/> Total of 1 forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Dimitri T. Azar	Art Unit :	3738
Serial No. :	10/712,294	Examiner :	William H. Matthews
Filed :	November 13, 2003	Conf. No. :	8876
Title :	ABERRATION-CORRECTING VISION PROSTHESIS		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program (extended January 10, 2006), a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1, 8-11, 13-18, and 20-26 are pending, of which claim 1 is independent. All the claims stand rejected as follows:

Claims 1, 9-11, 15-17, 21, 22, 24, and 25 stand rejected under 35 U.S.C. 102(b) as anticipated by Kern (U.S. 4,601,545). Claims 8, 13, 14, and 23 stand rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Rizzo (U.S. 5,800,530). Claim 20 stands rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Sandsted (U.S. 6,749,632). Claim 26 stands rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Nelson (U.S. 7,127,299).

Applicant specifically requests the panel to review the following issues:

1. The Examiner has made a clear error in the standard used to support a *prima facie* 102(b) rejection of claim 1.

2. The Examiner has made a clear error in failing to give patentable weight to claim limitations of claims 23-25.

3. A statement made in the Advisory Action of September 20, 2007 is factually incorrect.

Each of these issues is discussed in greater detail below. Applicants reserve the right to expand these issues and/or present new issues when filing their appeal brief, including issues raised in previous replies filed on January 9, 2007, May 15, 2007, and August 20, 2007, each of which is incorporated herein by reference.

Discussion of Issues:

1. The Examiner has made a clear error in the standard used to support a *prima facie* 102(b) rejection of claim 1.

The Examiner has made a clear error in the standard used to support the 35 USC 102(b) rejection of claim 1. In view of this error, Kern fails to disclose all limitations of independent claim 1. Thus, Kern fails to support a *prima facie* 35 USC 102(b) rejection of claim 1.

Applicant submits that Kern neither discloses nor suggests at least that “the wavefront data is configured according to a selected a high-order aberration correction to modify the characteristic function of the optical element to reduce high-order aberration in the eye,” as recited by claim 1.

In the pending Office Action, as in the previous Office Action, the Examiner is interpreting the RAM or ROM in the CPU 54 as the recited “memory element,” and the “instructions regarding distribution of voltage levels” as the recited “wavefront data.” The Examiner refers to col. 5, lines 45-47 as disclosing an “aspheric lens effect ... which reduce high order, or spherical, aberration.”

The Examiner is interpreting the phrase “the wavefront data is configured according to a selected a high-order aberration correction” as reading on the instructions stored in the memory of Kern because the electrodes of Kern correct a selected high-order aberration. It appears that the Examiner is making an argument that Kern inherently discloses that the instructions stored in the memory are configured according to a selected high-order aberration correction, as Kern does

not explicitly disclose that the instructions stored in the memory are configured according to any aberration correction, much less, a “selected a high-order aberration correction.”

Applicant respectfully points out that “to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In Kern, not only are there other possibilities for configuring the instructions in the memory besides “according to a selected high-order aberration correction,” as the claim requires, but Kern specifically describes that it is the electrode arrangements that achieve effects such as the “aspheric lens effect” which provide the aberration correction. Thus, Applicant submits that the rejection of claim 1 is based on a clear error in establishing a valid *prima facie* anticipation rejection based on inherency, and requests reconsideration. Applicants submit that this error is not a matter of interpretation of the claims or prior art teachings, but instead a matter of using the proper standard for a rejection based on inherent disclosure. For example, this error remains even if the Examiner’s interpretation of the prior art and claim 1 is assumed to be correct.

2. The Examiner has made a clear error in failing to give patentable weight to limitations of claims 23-25.

The Examiner has made a clear error in failing to give patentable weight to claim limitations of claims 23-25. Thus, the 35 USC 103(a) rejection of claim 23, and the 35 USC 102(b) rejections of claims 24-25 are improper.

Applicant submits that no proper combination of Kern and Rizzo teaches or suggests that the “wavefront data depends on an estimate of a distance to an object-of-regard,” as recited by claim 23. Applicant submits that Kern does not disclose that the “memory element is configured to enable the wavefront data to be re-programmed in situ,” as recited by claim 24, or that the “memory element is configured to enable the wavefront data to be re-programmed by transmitting data over a wireless link,” as recited by claim 25.

In the telephone interview of July 10, 2007 (as summarized in the reply filed August 10, 2007) the Examiner explained that he was not giving patentable weight to the limitations of claims 23-25, since they were being treated as merely "intended use." In the Examiner's interview summary filed on July 25, 2007, the Examiner states with respect to claims 1, 23 – 25 that "the limitations, of intended use, failed to positively recite additional structure beyond Kern and Rizzo." Applicant submits that the failure to give the limitation of claim 23 patentable weight is a clear error, since claim 23 goes beyond mere intended use of the memory element and places a further limitation on the wavefront data stored therein. Applicant submits that the failure to give claims 24-25 patentable weight is a clear error, since these claims go beyond mere intended use of the memory element and place further limitations on how the claimed memory element is configured.

Thus, Applicant submits that the rejections of claims 23-25 are based on a clear error and submits that this error is not a matter of interpretation of the claims or prior art teachings, but instead a matter of a failure to give patentable weight to proper claim limitations.

3. A statement made in the Advisory Action of September 20, 2007 is factually incorrect.

The Advisory Action mailed September 20, 2007, on the Continuation sheet states: "Regarding claims 24 and 25, the claim limitations recite the device to be capable of performing a function. Kern discloses structure that is capable of performing the functions."

Applicant submits that this statement of what is disclosed in Kern is factually incorrect and the Examiner has offered no specific factual basis for the statement. To the contrary, as discussed above, the Examiner argued that no such disclosure in Kern was necessary since the limitations were not being given patentable weight. If the Examiner has reconsidered and is now giving patentable weight to the limitations of claims 24 and 25, a factual basis should have been given to support the statement that "Kern discloses structure that is capable of performing the functions," such as a citation to a specific portion of Kern that contains such disclosure of the claim limitations.

In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested.

Applicant : Dimitri T. Azar  
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\$60 for the Petition for Extension of Time fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account Authorization. Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 00633-041001.

Respectfully submitted,

Date: October 19, 2007

/Elliott J. Mason, III/

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